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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/660,076   | 09/10/2003  | Dov L. Randall       | 0112300-1626        | 6170             |
| 29159  | 7590        | 11/01/2005           | EXAMINER            |                  |
| BELL, BOYD & LLOYD LLC<br>P. O. BOX 1135<br>CHICAGO, IL 60690-1135 |             |                      | NGUYEN, KIM T       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3713                |                  |
| DATE MAILED: 11/01/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

TAK

**Office Action Summary**

Application No.

10/660,076

Applicant(s)

RANDALL ET AL.

Examiner

Kim Nguyen

Art Unit

3713

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/17/04, 6/10/05, 8/18/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Examiner acknowledges receipt of the preliminary amendment on 8/8/05.

According to the amendment, claims 1-47 are pending in the application.

### ***Claim Objections***

1. Claims 1, 24 and 47 are objected to because of the following informalities:
  - a) In claim 1, lines 13-14; and claim 24, line 13, the claimed limitation "a player" should be corrected to "the player".
  - b) In claim 47, line 11, the claimed limitation "the indication" should be corrected to "an indication".

Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-128 of copending Application No. 10/237,207 in view of Vancura (US 2003/0216162).

4. Claims 1-47 disclose the same subject matter taught in claims 1-128 of the copending Application No. 10/237,207 such as providing a plurality of award opportunities, allowing the player to pick one of the award opportunities, and providing the player with the outcomes associated with the award opportunity picked by the player. Moreover, Vancura discloses an accumulated award opportunity (paragraphs 0022 and 0027). An ordinary person skilled in the art would be able to implement the accumulated award opportunity taught by Vancura to the gaming device of the copending Application No. 10/237,207 in order to provide the player more types of award.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura (US 2003/0216162) in view of Glavich (US 6,309,300).**

As per claim 1, 3, 13 and 15, Vancura discloses a gaming device comprising a game, a plurality of award opportunities (e.g. icons 20 in Fig. 1) including an accumulated award opportunity (e.g. Colonel Mustard) which includes a plurality of components (e.g. value 15 and number of extra pick 1) (paragraph 0027); a plurality of outcomes (paragraph 0025); and a processor for indicating (displaying) of at least two of the award opportunities (displaying 3x5 matrix showing cards 20 in Fig.1) including an accumulated award opportunity (e.g. Colonel Mustard), and awarding the player (paragraph 0027). Vancura does not explicitly disclose displaying the accumulation of the components. However, Glavich discloses displaying the accumulation of the components 143 (Fig. 1) (e.g. PICKS left, REVEALED PRIZE, MULTIPLIER, TOTAL PRIZE). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply displaying the accumulation of the various awards obtained by the player as taught by Glavich to the gaming device of Vancura in order to inform the player the accumulated awards he currently obtained.

As per claim 2, Glavich discloses generating awards associated to the award opportunity randomly (col. 6, lines 6-9).

As per claim 4, Vancura discloses combining the accumulated award by a mathematical operation (paragraphs 0022, 0027 and 0031).

As per claim 5, Vancura discloses using the accumulated components (e.g. number of picks) in another game (e.g. another set of icons) (paragraph 0027).

As per claim 6, 19-20, associating a probability with an award would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 7-9, Vancura discloses including two different accumulated award opportunities, which include different types of components such as free activations and a multiplier (paragraph 0027 and claims 3-5).

As per claim 10-12, Vancura discloses including a plurality of component-accumulating positions (e.g. globe positions 1-15) with a plurality of component-accumulating positions (e.g. globe position 4 includes value 1x and 2 additional picks) (paragraph 0022).

As per claim 14, refer to discussion in claim 6 above.

As per claim 16-18, Vancura discloses indicating award opportunities (e.g. Suspect screen, Weapon screen, etc.) upon a trigger event occurs (paragraphs 0022 and 0027).

As per claim 21, allowing a computer to randomly select an award would have been both well-known and obvious design choice.

As per claim 22-23, Vancura discloses a multiplier or free spins awards (paragraph 0027).

As per claim 24-25, refer to discussion in claim 1 above. Further, Vancura discloses a pair of award opportunities (e.g. suspect screen, weapon screen in paragraph 0027). Implementing a plurality of pairs of award opportunities would have been obvious design choice and would require only routine skill in the art.

As per claim 26-27, Vancura discloses including two different types of award opportunities (e.g. award opportunity and accumulated award opportunity) (paragraph 0027). Further, implementing the same accumulated award opportunity in the pair of award opportunities both well known and obvious design choice.

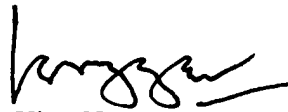
As per claim 28-46, refer to discussion in claims 1-2 and 4-10, 12, 16-18, and 21-23 above.

As per claim 47, refer to discussion in claim 1 above. Further, Vancura discloses including a sub-game (e.g. Weapon screen, Room screen) (paragraph 0027). Further, pre-assigning an expected average outcome for each award opportunity would have been well-known and obvious design choice according to a game designer's preference.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

kn  
Date: October 27, 2005

  
Kim Nguyen  
Primary Examiner  
Art Unit 3713